

### **REMARKS**

Applicants have amended Claim 1. Support for the amendment can be found generally throughout the text, specifically at page 4, line 20 - page 5, line 3.

Applicants respectfully submit that no new matter has been added by the present amendment.

#### **I. Rejection under 35 U.S.C. §102(b)**

Claims 1-3 and 5-7 were again rejected under 35 U.S.C. § 102(b) as being anticipated by Well (U.S. Patent No. 5,905,107). Applicants respectfully traverse this ground of rejection. In order to anticipate a claim, the prior art reference must teach each and every element of the claim, either expressly or inherently. Applicants respectfully submit that Well fails to teach each and every element of the claimed invention.

The present invention is directed to rubber compounds comprising at least one double bond-containing rubber (A) and **polybutadiene rubber gels having a diameter of 5 to 1,000nm and a glass transition temperature of <-60°C** (B), whereby component (B) is present in quantities of 10 to 150 wt.%, relative to the total quantity of component (A), and optionally other fillers and rubber auxiliary substances in conventional quantities.

Applicants submit that Well discloses an unvulcanized mixture comprising S-SBR and silicic acid, silanization agent, TBzTD and CBS. See Column 1, lines 48-61. Also according to the disclosure of Well, the unvulcanized rubber mixture can contain polybutadiene (BR). Well does not teach or suggest each and every element of the claimed invention, specifically Well does not teach or suggest component B, i.e. **polybutadiene rubber gels having a diameter of 5 to 1,000nm and a glass transition temperature of <-60°C**. Well does not teach using **rubber gels** having the claimed transition temperature and diameter.

Applicants also assert that whether a material is called "polybutadiene rubber", "polybutadiene particles" or "polybutadiene rubber gels" is not simply a matter of nomenclature. Applicants submit these are different materials and that such a differentiation is readily known by those skilled in the art. Applicants further draw the Examiners attention to page 4, lines 16- page 5, line 21. As discussed in the specification, rubber gels useful in the present invention are prepared according to U.S. Patent No. 5,395,891. Further, as discussed in the Specification, component Mo6025

A is a rubber, such as a BR, according to DIN/ISO 1629. Accordingly, Applicants submit one skilled in the art would recognize that a rubber gel is different from rubber, and therefore, Applicants also submit that the Examiners citation to Aldrich Chemical Catalog for the glass transition temperature of a polybutadiene polymer is irrelevant given the difference between a rubber and a rubber gel. Applicants accordingly request withdrawal of this ground of rejection.

## **II. Rejection Under 35 U.S.C. § 102(b)**

Claims 1-3, 5 and 7 were rejected under 35 U.S.C. § 102(b) as being anticipated by Sandstrom, et al. (U.S. Patent No. 5,534,574). Applicants respectfully traverse this ground of rejection and herein incorporate the arguments above.

Applicants respectfully submit that Sandstrom, et al. fails to teach each and every element of the claimed invention either expressly or inherently. Sandstrom, et al. teaches a rubber composition comprised of an elastomer (at least one diene based elastomer, i.e. SBR and BR), silica, carbon black, polysulfide coupler and a thiazole. Sandstrom, et al. does not disclose either a **BR rubber gel having the claimed diameter** or a **BR rubber gel having the glass transition temperature as claimed, i.e. <-60°C.**

Applicants resubmit their comments above relating to the difference between rubber and rubber gels. Accordingly, based on the above, Applicants submit that Sandstrom, et al. does not teach each and every element of the claimed invention either expressly or inherently.

## **III. Rejection under 35 U.S.C. § 103(a)**

Claim 4 was again rejected under 35 U.S.C. § 103(a) as being unpatentable over Well or Sandstrom, et al., each individually in view of Wolpers, et al. (EP 530,590). Applicants respectfully traverse this ground of rejection and incorporate the arguments above.

"To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. In re Royka, 490 F.2d 981, 180 USPQ 580 (Fed. Cir. 1974)". Applicants also respectfully submit that "in order to establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference. Second, there must be a reasonable expectation of success. Finally, the prior art references must teach or suggest all the claims limitations. The teachings or suggestions to

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make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicants' disclosure." See MPEP § 2142, citing In re Vaeck, 947 F.2d 488, 20 USPQ 2d. 1438 (Fed. Cir. 1991).

Claim 4 is dependent upon Claim 1, therefore if Claim 1 is allowable, Applicants respectfully submit that Claim 4 would be allowable. Applicants submit, as argued above, Well and Sandstrom, et al. fail to teach or suggest the claimed invention, therefore even if there was motivation to combine the teachings of Wolpers, et al., the combination would not teach each and every element of the claimed invention i.e., the claimed rubber gel. Accordingly, Applicants submit that one skilled in the art would not arrive at the instant invention in view of Well or Sandstrom, et al., each individually in view of Wolpers, et al., therefore Applicants request withdrawal of this ground of rejection.

**VI. Rejection under 35 U.S.C. § 103(a)**

Claim 6 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Sandstrom, et al. in view of Well and Kondo, et al. (U.S. Patent No. 5,393,816). Applicants respectfully traverse this ground of rejection and incorporate the arguments above.

Claim 6 is dependent upon Claim 1, therefore if Claim 1 is allowable, Applicants respectfully submit that Claim 6 would be allowable. Applicants submit, as argued above, Well and Sandstrom, et al. fail to teach or suggest the claimed invention, therefore even if there was motivation to combine the teachings of

Kondo, et al., the combination would not teach each and every element of the claimed invention. Accordingly, Applicants submit that one skilled in the art would not arrive at the instant invention in view of Sandstrom, et al. in view of Well and Kondo, et al., therefore Applicants request withdrawal of this ground of rejection.

Respectfully submitted,

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